

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claims 26 and 27 have been added to recite the data record is loaded with data, programs, and/or keys from an owner initiated log in with the payee. It is respectfully submitted that no new matter is added, since support for the claim may be found for example, at least, in paragraph [0033] of the specification as originally filed.

2. Rejection of claims 1-4, 6-7, 10, 14-22, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. pat. no. 5,602,919 (Hurta et al.) in view of U.S. pub. no. 20020049670 (Moritsu et al.)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claims 1 and 17, from which claims 2-4, 6-7, 10, 13-16, 18-22, and 24-25 depend.

By way of review, claim 1 recites a method for using an electronic intermediate carrier that is configured to perform cashless processing of a transaction for paying for a service. This method of cashless processing has the steps of at a first time, receiving a data record assigned to the service from an owner's personal electronic payment device. The step then requires at a second time, which is later than the first time, checking the data record or data derived therefrom in the electronic intermediate carrier by a receiving device of the payee. Then the data record is deleted or invalidated completely or with regard to the data derived therefrom in the electronic intermediate carrier if the service was rendered correctly. The electronic intermediate carrier is formed as a transferable

unit physically separate from the owner's personal electronic payment device or personal electronic device (emphasis added).

As the specification discloses, the transferable electronic intermediate carrier has advantages over the prior art by allowing the owner of the personal electronic device to use the payee's infrastructure without any need to contact the payee (paragraph [0010]). The electronic intermediate carrier provides both the overpayments to be refunded and the possibility of additional payment by the payee by providing the information for payment (paragraph [0010]). The transferability of the electronic intermediate carrier is designed for multiple use by allowing the deletion and invalidation of the data record at the second time (paragraph [0014]).

For example, a cash card, i.e., a chip card with a purse function, transmits a data record, i.e., data information assigned for a particular payment, to a transponder (paragraph [0018]). During this data transmission, an amount of money or units of value can also be transmitted from the cash card to the transponder (paragraph [0034]). The transponder is then received by the payee, who then uses a checking device to check the data record and perform a data exchange (paragraphs [0020], [0022]). If the data record renders the performance correctly, the amount of money or units of value are deleted or marked as invalid (paragraph [0023]).

The method recited in claim 1 is further explained by way of another example, where the transponder can be part of an envelope that can be embedded into the paper (paragraph [0037]). At a first time, the cash card will transmit a data record to transmit an amount of money corresponding to the postage to the transponder (paragraph [0037]). When the letter is received by the post office, the payment of the postage will be checked with a receiving device at the post office (paragraph [0037]). The transponder is then allowed for multiple use by attaching it to another letter for subsequent users (paragraph [0038]).

It is respectfully submitted that the proposed combination of the *Hurta* patent and the *Moritsu* publication fails to disclose an electronic intermediate carrier formed as a transferable unit physically separate from the owner's personal electronic payment device as recited in amended claim 1.

The *Hurta* patent discloses information that is generated by a smartcard and then stored in the transponder (column 5, lines 21-22). The toll booth interrogator wakes up the transponder, which identifies itself to the interrogator with the necessary information for data transmission and fee payment (column 6, lines 3-24). At most, the *Hurta* patent discloses depositing money values at a first place and then dispensing those money values at a different place. In other words, the smartcard can load money or a certificate onto the transponder, but the transponder has the disadvantage of its lack of mobility since it is generally stored on a single automobile, i.e., a single user (column 7, lines 46-55). Therefore, it is respectfully submitted that the *Hurta* patent fails to disclose a transferable electronic intermediate carrier that is physically separate from the owner's personal electronic payment as recited in claim 1.

Turning to the *Moritsu* publication, the *Moritsu* publication discloses an electronic payment method and electronic payment system that sends a payment intermediary a payment intention notification (paragraphs [0009] – [0011]). When the payment intention notification is received, a deposit account notification is sent to the payment intermediary (paragraph [0011]). The payment intention is data indicating that the party or the entrusted agent registered in the payment intention is to pay the payment amount (paragraph [0040]). During the deposit request procedure, the payment intention is encrypted and sent (paragraph [0062]). However, it is respectfully submitted that the *Moritsu* publication at most discloses a payment method that only has steps that are pure data operations, unlike the physically separate transferable electronic intermediate carrier as recited in claim 1.

At most, the proposed combination of the *Hurta* patent and the *Moritsu* publication discloses a stationary transponder assigned to one user that can be used to send and receive data records to effectuate a transfer of money. However, it is respectfully submitted that one having ordinary skill in the art would not be led by the transponder disclosed in the *Hurta* patent in combination with the disclosure of the *Moritsu* publication to a transferable electronic intermediate carrier that is physically separate from the owner's personal electronic payment device for cashless processing as recited in claim 1.

The transferable electronic intermediate carrier recited in claim 1 allows the user to send a data record to the electronic intermediate carrier at a first time, then at a second time have a receiving unit check the data record in the electronic intermediate carrier, and finally deleting or invalidating the data record if the service was rendered correctly. In other words, it is respectfully submitted that these steps allow the uploading of money to an electronic intermediate carrier, which can then be transferred to another article, e.g., an envelope or merchandise in a supplier's premises. After the transference of the electronic intermediate carrier, the payee can then use a receiving device to check the data record on the transferable electronic intermediate carrier and delete or invalidate the data record. The deletion and invalidation of the data record allows the subsequent reuse of the transferable electronic intermediate carrier.

However, the proposed combination of the *Hurta* patent and the *Moritsu* publication only discloses a stationary transponder that is assigned to a single user, while having a smart card that can be used in other applications (column 7, lines 46-55). Since the transponder is only disclosed as having a lack of mobility, it is respectfully submitted that this transponder is not transferable. In other words, the transponder from the proposed combination of the *Hurta* patent and the *Moritsu* publication is not physically forwarded from a first place to a second place to cause payment. Instead, the transponder is fixed, e.g., as a transponder for a toll transaction in a car. It is respectfully submitted that one having ordinary skill in the art would not then be led to transfer the transponder

disclosed by the proposed combination of the *Hurta* patent and the *Moritsu* publication to be used in a second place, absent an improper hindsight suggestion to do so.

Although the Office Action dated December 17, 2010 on page 11 suggests that the device/system disclosed in the *Hurta* patent and modified by the disclosure of the *Moritsu* publication could further be modified by the RFID chip disclosed in the *Tuttle* patent, it is respectfully submitted that the proposed combination would be improper. As discussed above, the *Hurta* patent at most discloses a stationary transponder that allows a transaction between an interrogator of a toll zone and the transponder that is fixed in a car. In fact, the inventors of the *Hurta* patent acknowledge the lack of mobility of the transponder (column 7, lines 46-55). Therefore, it is respectfully submitted that one having ordinary skill in the art would not then be led to combine the disclosure of the *Hurta* patent and the *Moritsu* publication with the RFID chip of the *Tuttle* patent.

It is respectfully submitted that only through the present disclosure, is one having ordinary skill in the art led to a method for cashless processing that uses a transferable electronic intermediate carrier that can be physically forwarded from a first place to a second place. In fact, there is no suggestion or disclosure in the *Tuttle* patent of processing the data record to effectuate cashless processing, and the *Tuttle* patent at most discloses using an RFID system to only provide information and identification (column 4, lines 48-55). In other words, one having ordinary skill in the art could not simply modify the transponder disclosed in the *Hurta* patent with the disclosure of the *Tuttle* patent to disclose a method of cashless processing using a transferable electronic intermediate carrier, as recited in claim 1. Instead, it is respectfully submitted that to include the RFID chip disclosed in the *Tuttle* patent with the transponder disclosed in the *Hurta* patent, would require extensive non-obvious modification to the systems in order for the disclosures to work together.

Since the proposed combination of the *Hurta* patent and the *Moritsu* publication fails to disclose or suggest each and every feature of claim 1, a *prima facie* case of

obviousness has not been established. Therefore, withdrawal of this rejection is respectfully requested.

Claim 17 recites similar structural features as are recited in claim 1, as well as its own recited features. Therefore, a *prima facie* case of obviousness cannot be established with respect to claim 17, since the proposed combination of the *Hurta* patent and the *Moritsu* publication at least fails to disclose or suggest a transferable electronic intermediate carrier as recited in claim 17.

It is submitted since independent claims 1 and 17 are considered to be patentable, claims 2-4, 6-7, 10, 14-16, 18-22, and 24-25, which depend from claims 1 and 17, are also considered to be patentable as containing all of the steps or elements of claims 1 and 17, as well as for their respective recited features.

3. Rejection of claims 5 and 23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. pat. no. 5,602,919 (*Hurta et al.*) in view of U.S. pub. no. 20020049670 (*Moritsu et al.*) and further in view of Official Notice

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claims 1 and 17, from which claims 5 and 23 depend.

A *prima facie* case of obviousness has not been established with respect to claims 1 and 17, from which claims 5 and 23 depend, on the basis that the Official Notice fails to provide for the deficiencies of the proposed combination of the *Hurta* patent and the *Moritsu* publication as discussed above with respect to claims 1 and 17.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Rejection of claims 9 and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over U.S. pat. no. 5,602,919 (*Hurta et al.*) in view of U.S. pub. no. 20020049670 (*Moritsu et al.*) and further in view of U.S. pat. no. 6,013,949 (*Tuttle*)

Reconsideration of this rejection is respectfully requested on the basis that the rejection fails to establish a *prima facie* case of obviousness with respect to claim 1, from which claims 9 and 11-13 depend.

A *prima facie* case of obviousness has not been established with respect to claim 1, from which claims 9 and 11-13 depend, on the basis that the *Tuttle* patent fails to provide for the deficiencies of the proposed combination of the *Hurta* patent and the *Moritsu* publication as discussed above with respect to claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

5. New Claims

Claims 26 and 27 are patentable over the cited prior art references at least for their dependency on claims 1 and 17, as discussed above in detail, as well as for their respective recited features.

For example, claims 26 and 27 recite loading the data record with data, programs, and/or keys from a previous owner initiated log in with the payee. It is respectfully submitted that the prior art references fail to disclose at least this feature of new claims 26 and 27.

Accordingly, claims 26 and 27 are patentable over the cited prior art.

6. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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